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EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/966,487
Filing Date: September 28, 2001
Appellant(s): ALDRIDGE, C. KENT

MAILED
MAY 26 2005
Group 3700

Alexander M. Gerasimow
For Appellant

**SUPPLEMENTAL
EXAMINER'S ANSWER**

Issues

This Supplemental Examiner's Answer is in response to The Board of Patent Appeals and Interference's "Remand to the Examiner" dated April 29, 2005. The Board remanded the application back to the Examiner to consider Appellant's rebuttal arguments to the Examiner's Answer raised in the Appellant's Reply Brief dated April 23, 2004.

Appellant argues, as in the Appeal Brief, that neither Mondak nor Reiter teach or suggest, "either alone or in combination are: 'crimping a first seal member to the first interface surface of the inner ring' and 'crimping a second seal member to the second interface surface of the outer ring.'" Reply Brief, page 2. Furthermore, Appellant contends "[t]he Examiner simply has not provided an adequate motivation for the suggested combination." Reply Brief, page 3. The new issue raised by Appellant is whether the Reiter reference inherently suggests the step of "crimping a first seal member to the first interface surface of the inner ring." Reply Brief, page 4.

Response to Argument

First of all, the issue is it is not whether Reiter suggests the step of "crimping a first seal member to the first interface surface of the inner ring," but whether the combination of Mondak and Reiter suggests this limitation. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*,

642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). *See also In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

Appellant contends that the method and tool of Reiter is incapable of crimping the seal of Mondak, since the tool shown in Figure 4 of Reiter can only crimp the seal on the exterior surface of the bearing assembly and can not crimp a seal on the inner bearing race. *See Reply Brief*, page 4 (“[The bearing design of Mondak] requires a different tool and a different approach to crimping than the approach to crimping followed by Reiter.”). A close inspection of Reiter however reveals “The axial wall 62 of each seal case 60 may be deformed into its annular groove 32 on the cup 24 or 26 by *any number of procedures*.” Col. 7, lines 17-19 (emphasis added). Thus, the reference itself does not preclude other crimping processes and/or tools, and by implication leaves open the possibility of such. The reference goes on further to note “Perhaps the most suitable involves an assembly fixture F (FIGS 4 & 5) ...” *Id.*, lines 19-20. Therefore, Reiter only considers the crimping tool shown in Figure 4 a preferred embodiment.

“Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments.” MPEP § 2123; *see also Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 807 (Fed. Cir. 1989) (A reference may be relied upon for all that it would have reasonably suggested to one having

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ordinary skill the art, including nonpreferred embodiments.) Just because a prior art reference contains a feature that is not in the present invention does not mean that the prior art teaches away from the present invention. See *Jore Corp. v. Kouvato, Inc.*, 117 Fed. Appx. 761, 764 (Fed. Cir. 2005). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the [Appellant]. The degree of teaching away will of course depend on the particular facts; *in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the [Appellant].*" *In re Gurley*. 27 F.3d 551, 553 (Fed. Cir. 1994) (emphasis added). Reiter discloses a result that is productive to Appellant, *i.e.*, forming a permanent attachment of the seal member to the bearing race by a crimping process to unitize the bearing and to prevent damage to the seal element from being installed incorrectly. See Col. 7, lines 41-50. Reiter discusses that prior art seals are often inverted when the bearing unit is installed allowing contaminants to enter the interior of the bearing. See Col. 1, lines 50-60. A permanently mounted seal is thus a benefit over snap-fit and removable seals, such as taught by Mondak.

Appellant's claimed invention is directed towards a method for mounting seal to a bearing rather than a specific crimping tool. See Claim 8 and 15. One having ordinary skill in the art at the time the invention is made would have been capable of selecting a crimping process (tool) suitable for a given bearing structure in order to crimp a seal into an annular groove. See *e.g.*, JP 01-262030 & 09-229079 (showing prior art crimping

processes to crimp a seal into internal annular groove in the bearing). Reiter, as discussed above, does not preclude such and expressly teaches this may be performed “by any number of procedure.” Col 7, lines 17-19. Furthermore, even Appellant requires a different process (tool) for crimping the first and second seal members. *Compare* Figure 3 (showing tool for mounting seal to outer ring) *with* Figure 6 (showing tool for seal member to inner ring).

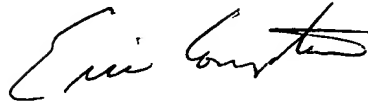
Lastly, Appellant argues, “the burden is not on the Appellant to show a reason not to combine the reference.” Reply Brief, page 3. The Examiner recognizes that the PTO bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. However, once “the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.” *Id.* As noted in the Examiner’s Answer and above the Examiner maintains that a *prima facie* case of obvious has been shown. Thus, the Examiner’s comment in the Examiner Answer that, “Appellant has not put forth any evidence that the method of Reiter is unreliable or unsuccessful,” is consistent with Appellant’s shifting burden to overcome the *prima facie* case.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eric Compton", with a stylized flourish at the end.

Eric B. Compton
Primary Examiner
Art Unit 3726

ebc
May 23, 2005

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